

Serial No.: 10/065,286
Attorney Docket No.: F-380

Patent

REMARKS

1. Status of Claims

Claims 1-16 were pending in the Application. Applicant has amended claim 8. Applicant respectfully request entry of the above amendments and consideration of the enclosed remarks. Applicant respectfully submits that no new matter is added. Accordingly, claims 1-16 will remain pending in the application.

2. Claim Objections

In section 2 of the Office Action, the Examiner objected to claim 8. Applicant has amended claim 8 without prejudice or disclaimer and respectfully requests that the Examiner withdraw the objection.

3. Claim Rejections

In section 4 of the Office Action, the Examiner rejected claims 1, 2, 6, 7-10 and 16 under 35 U.S.C. 103(a) as allegedly rendered obvious by seven references including U.S. Patent No. 6,524,846 to Robinson, Jr. ("Robinson '846"), United States Patent Application Publication 2004/0046009 to Weisenberg, et al. (Weisenberg '009"), United States Patent Application Publication 2003/000140015 to Applebaum (Applebaum '015") and/or United States Patent Application Publication 2003/0085266 to Simon (Simon '266") and in further view of U.S. Patent No. 5,179,281 to Tawil, et al. ("Tawil '281").

Applicant respectfully traverses the rejection.

Initially, Applicant appreciates the Examiner providing a copy of the related provisional patent application in the Simon '266 reference. Applicant notes that the reference is not entitled to its earlier filing date for all material. Accordingly, Applicant respectfully submits that the reference is not available as prior art for all material and requests that the Examiner cite to the provisional case if the reference is relied upon.

Applicant also respectfully submits that the references are not properly combined. For example, the Tawil '281 reference does not appreciate the problem of providing a test strip that changes color and is visible through a hole. In Tawil '281,

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the test strip is inserted in a remote reader to determine radiation dosage levels and is in no way related to the art of test strips providing a visible indication. As the Federal Circuit has held, “[I]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art ...” See *In re Fitch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992)(quoting *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1998).

Furthermore, the Tawil '281 reference describes devices, systems and methods for measuring radiation dosage received by a user wearing the device. Clearly, Tawil '281 is not even remotely related to envelope test strip devices and is not at all pertinent to the claimed invention. Accordingly, the references are not properly combined. The rejections should be withdrawn because the references are not in an art analogous to that of the invention as presently claimed. See *Wang Lab., Inc. v. Toshiba Corp.*, 993 F. 2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

Furthermore, the Examiner states that without the Tawil '281 reference that the invention as presently claimed would still be deemed obvious. However, the Examiner does show any teaching or suggestion in the art to support such a rejection.

Claims 2, 6-10 and 16 depend directly or indirectly from claim 1 and are patentable over the cited references for at least the reasons stated above.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections.

In section 5 of the Office Action, the Examiner rejected claims 3-5 under 35 U.S.C. 103(a) as allegedly rendered obvious by the five references listed above and in further view of a sixth reference, namely U.S. Patent No. 4,840,919 to Attar (“Attar '919”).

Applicant respectfully traverses the rejection.

Claims 3-5 depend directly or indirectly from claim 1 and are patentable over the cited references for at least the reasons stated above. Furthermore, Attar '919

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does not appreciate the problem of placement of a holder in relation to an envelope and holes as claimed. In direct contradiction to the rejection provided, the holder as claimed allows the test strip to be reused, while the device of Robinson, Jr. '846 is embedded. Therefore, the Examiner has impermissibly used the invention as presently claimed and improper hindsight in formulating the rejection. The cited references do not appreciate the problem of reusing the test strip and placing it in a holder to enable viewing it through the hole.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections.

In section 6 of the Office Action, the Examiner rejected claims 11-15 under 35 U.S.C. 103(a) as allegedly rendered obvious by the five references listed above in regard to the rejection of section 4 and in further view of the legal precedence established in the opinion of In re Ngai, 70 USPQ 2d 1862 (Fed. Cir. 2004).

Applicant respectfully traverses the rejection.

Claims 11-15 depend directly or indirectly from claim 1 and are patentable over the cited references for at least the reasons stated above.

Furthermore, the Applicant respectfully submits that the Examiner has misconstrued the holding of the Ngai decision. The Federal Circuit did not state that all instructions would not add patentable weight to an underlying object. In fact, if the instructions are interrelated so as to produce a new product, the Federal Circuit stated that the new product might indeed be patentable. See In re Ngai, 367 F.3d 1336, 1338, 70 USPQ 2d 1862 (Fed. Cir. 2004).

Here, the invention as claimed in claims 11-15 recites a warning message on the envelope that is clearly interrelated with the underlying object.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections.

Accordingly, Applicant submits that the invention as presently claimed in claims 1-16 is in condition for allowance.

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4. Conclusion Of Remarks

For at least the reasons stated above, it is respectfully submitted that the claims of this application are in condition for allowance and early and favorable action thereon is requested.

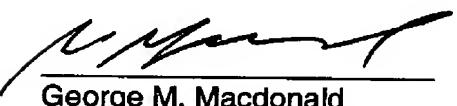
If the Examiner believes that additional issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned attorney for Applicant at (203) 924-3180.

5. Authorization

No fee is believed due with this Amendment. However, the Commissioner is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-380.

In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely. The Commissioner is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-380.

Respectfully submitted,


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